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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,363	Applicant(s) KIM, KI IL	
	Examiner Charles N. Appiah	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122, 124-134, 136-138 and 140-143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-122, 124-134, 136-138 and 140-143 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/27/20/04, 1/19/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Eighth Preliminary Amendment the claims pending are 1-122, 124-134, 136-138 and 140-143.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-122 and 124-134, 136-138, and 140-143 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,681,120. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims of the instant application are broad enough to be encompassed by the claims of the patent and as such it would have been obvious to one of ordinary skill in the art to implement the invention of the claims of the instant application using the claims of the patent for providing multimedia services to mobile subscribers.
4. Claims 1-122, 124-134, 136-138 and 140-143 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 26-47 of copending Application No. 11/047,866. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims of the instant application are encompassed by the claims of the '363 application and it would be obvious to implement the invention of the instant application using the claims of the '363 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 70-72, 80-91, 113, 114, 117, 118, 119 and 120 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear and adequately disclosed how the limitation "at least one of music player, with or without moving images or a radio provided in said portable housing for

providing entertainment" recited in claims 70, 80, 84-86, 88, 90, 91, 113, 114, 117, 118, 119 and 120 is provided in the portable housing.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 122 is rejected under 35 U.S.C. 102(e) as being anticipated by Kubo (6,101,372).

Regarding claim 122, Kubo discloses in a mobile entertainment and communication device (see Fig. 2B) for communicating with remotely located telephones by a cell phone, (with reference to Fig. 6) a replaceable memory card (22) having a flat rectangular shape with at least one corner (22c) having an irregular shape that is different than the other corners for causing proper orientation of the memory card

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in the cell phone (see chamfered corner 22C, col. 5, line 55 to col. 6, line 8), the memory card having at least one hole for use in securing the memory card in the cell phone

3. Claims 27- 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Tendler (5,555,286).

Regarding claim 27, Tendler discloses a mobile entertainment and communication device for communicating with remotely located telephones, comprising: a cell-phone in a portable housing of a size and weight for being handheld by a person for placing and receiving person-to-person telephone calls to and from remotely located telephones, the cell phone having a microphone and a speaker (see cellular phone 10, having microphone 14 and earpiece 16, see col. 50-52), an audible alarm means including at least one of the speaker or a separate audible sound generator activation of module 20 causing message MAYDAY MAYDAY MAYDAY to be verbally broadcasted, see col. 6, lines 48-60), and an emergency button on the housing and operatively connected to the audible alarm means for selectively operating the audible alarm means dialer and activation detector 24, coupled to the cellular telephone, see col. 5, lines 50-55, col. 6, lines 27-48).

Regarding claim 28, Tendler further discloses means for automatically dialing at least at least one of '911' or other emergency telephone numbers (see col. 5, lines 11-35, col. 6, lines 27-47).

Regarding claim 29, Tendler further discloses wherein the means for automatically dialing a telephone number includes the emergency button (see col. 7, lines 26-35).

Regarding claim 30, Tendler further discloses wherein the means for automatically dialing a telephone number comprises means separately operable from the emergency button (see col. 7, lines 45-65).

Regarding claim 31, Tendler further discloses including a global positioning system provided in the housing and operatively connected to the cell phone, the emergency button also activating the global positioning system for transmitting the position of the cell phone to at least one of the emergency telephone numbers (see col. 7, lines 36-44).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. At least claims 16, 17, 38, 49, 54, 59, 60, 84-86, 90-92, 118 and 124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler (5,555,286) in view of Kikinis (6,243,596).

With regard to representative broad claims like 16, 17, 38, 54, 59, 60, 84-86, 90 and 118, Tendler discloses a communication system comprising: a handheld cell phone

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for telephone calls and wireless calls and including a microphone (14), a speaker (16), a display (see display on phone 10), an inherent microprocessor and memory, a global positioning system (GPS), for transmitting real time position of the cell phone when connected with a pre-selected number (see col. 2, lines 41-59, col. 7, lines 32-44), the global positioning system being activated by at least one of voice control dialing a pre-selected number, manually dialing a pre-selected number or an emergency button that dials a pre-selected number (see col. 5, line 50 to col. 6, line 5), and means for causing operation of at least the microphone upon activation of the global positioning system for transmitting at least one of sounds, still images or moving images with the real time position to the telephone (see col. 6, lines 48-60). Tendler fails to explicitly teach the communication system including a camera, at least one of a music player with images, a music player without images or a radio in the hand held cell phone and the cellular phone having access to the Internet.

In an analogous field of endeavor, Kikinis discloses a cellular phone having the capability of accessing and browsing the Internet (see Fig. 2, col. 4, lines 19-39), and includes the capability of downloading audio using 'media player' which is converted into a form usable by field units (see col. 10, lines 22-56), which meets the limitation a music player without images. Kikinis further teaches that the handheld unit can be provided with a digital camera, which can be used to snap digital pictures, and sent over the Internet (see col. 10, line 62 to col. 11, line 3). Kikinis teaches a camera apparatus being provided with the handheld unit such that a user can snap digital pictures and send the data to the proxy-server or to any other machine (see col. 10, line 65 to col.

11, line 3), a first jack connection on the housing for a wired connection between the cell phone and at least one of the earpiece speaker, a separate microphone or both, and a second jack connection on the housing for a wired connection between the cell phone and a computer or other device for downloading data including sounds and at least one of moving images or combined sounds and moving images to an electronic device (see input Output (I/O) serial port 204, col. 17, lines 24-40). Additionally Kikinis further teaches the feature of the microprocessor providing operation for selectively capturing moving images, sound or simultaneous sound and moving images by camera and microphone and storing to memory, reproducing the sound moving images, sound or simultaneous sound and moving images by the display and the speaker and loading data to or from the Internet to an electronic device (see col. 10, line 57 to col. 11, line 3, col. 11, lines 44-57).

It would therefore have been obvious to one of ordinary skill to combine Kikinis' Internet capability handheld cellular device with Tendler's communication system in order to provide a device capable of performing sophisticated operations such as Web-browsing for subscribers.

7. Claims 111, 112, 115, 116 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler (5,555,286) in view of Kikinis (6,243,596) and Trahan et al. (5,257,414) and further in view of Anderson (5,721,783).

Regarding representative claims 111, 112, 115, 116 and 121, the combination of Tendler and Kikinis meet all limitations as applied to claims 16, 17, 38, 49, 54, and 84-86 above. Additionally Kikinis further teaches the feature of the microprocessor

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providing operation for selectively capturing moving images, sound or simultaneous sound and moving images by camera and microphone and storing to memory, reproducing the sound moving images, sound or simultaneous sound and moving images by the display and the speaker and loading data to or from the Internet to an electronic device (see col. 10, line 57 to col. 11, line 3, col. 11, lines 44-57), and Kikinis teaches the microprocessor providing operation for directing images to the display from the camera and from at least one of the telephone calls, the Internet, or memory, including the replaceable memory card, the microprocessor providing operation for causing at least one of playing images, skipping portions of images, synchronizing images with sounds (see col. 17, lines 9-33, col. Col. 18, line 39 to col. 19, line 21). The combination of Tendler and Kikinis fail to explicitly teach a memory card socket provided in the cell phone housing for receiving a replaceable memory card with substantially the entire card positioned within the housing and secured in the memory socket the replaceable memory card having a rectangular shape with at least one corner of an irregular shape different than the other corners, the card socket having at least one corner of an irregular shape that will receive the irregularly shaped corner of the card, the card socket being provided with a spring for urging the replaceable memory card out of the socket facilitating removal of the replaceable card from the socket and the card having at least one hole for use in securing the memory card in the socket.

Examiner maintains that the concept of using a replaceable memory card in a wireless device such as a radio telephone was very known in the art as taught for

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example by Trahan. Trahan discloses an apparatus for accepting and retaining a memory card in a radio telephone wherein the memory card is replaceable (removable) has a rectangular shape and exhibits an irregular shape (see illustration in Figs 3 and 4), for unique orientation of the card when positioned in a memory card chamber with ejector knob (405) which serves as a spring for urging the card out of the socket (chamber) upon release of the memory card engagement (contact cover 403 and inclined planes 415, 417, see col. 2, line 33 to col. 3, line 41, col. 4, lines 27-34), the feature of the replaceable memory card being positioned entirely within the cell phone being met by the attachment of the battery pack confining and protecting the SIM chip card to the area between the battery pack and the back of the portable transceiver (see col. 2, lines 33-45). According to Trahan having card entirely positioned and retained within the electronic device ensures a card reader, which is physically small, environmentally sealed, simply designed and durable (see col. 1, lines 56-60).

It would therefore have been obvious to one of ordinary skill in the art to incorporate Trahan's card retention apparatus into the combination of Tendler and Kikinis in order to provide a removable memory unit, which for a communication device, which is small, environmentally protected, simply designed and durable as taught by Trahan.

6. Claims 24, 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin (6,006,109) in view of Lee et al. (6,137,525).

Regarding claims 24 and 33 Shin discloses a mobile entertainment and communication device for communicating with remotely located telephones (see Figs.

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1-5), comprising a cell phone (500) in a portable housing of a size and weight for being handheld by a person (portable telephone 500, see col. 3, line 20), for placing and receiving person-to-person telephone calls to and from remotely located phones (cellular phone 500 is capable of transmitting and receiving data), the cell phone having an inherent microphone, an inherent speaker and an inherent memory (it is inherent that the portable telephone 500 has a microphone, a speaker and a memory), and a jack connection on the housing (510, 520) for a wired connection (512, 522) between the cell phone (500) and a separate device 80, 90) for at least downloading or uploading data therebetween (computer being able to transmit and receive data via portable telephone 500, see col. 3, lines 16-30, col. 4, line 63 to col. 5, line 38). Shin fails to explicitly teach wherein the data downloaded or uploaded between the cell phone and the separate device includes at least one of moving images, sound or combined sounds and moving images.

In an analogous field of endeavor, Lee discloses a personal data communication apparatus that provides a camera, magnified image in a display and a video telecommunication system within a compact handset housing (see Figs. 3, 4, 7 and 10). According to Lee, data (such image data) stored in the memory of the data communication device can be transmitted to a radio public telecommunication network in response to a signal requesting a video communication when the user desires (see col. 2, lines 11-24, col. 4, lines 14-65 and col. 5, lines 18-42).

It would therefore have been obvious to one of ordinary skill in the art to combine the video transmission capability of Lee with Shin's data communication system in order

to allow a user to make video communication without any additional device, as the user desires as taught by Lee.

Regarding claim 25, Shin further discloses wherein the separate device is at least one of a personal computer or a television (see computers 80, 90, Figs. 2, 4).

7. Claims 140 and 141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler (5,555,286) in view of Oliver (EP 0 830 000).

Regarding claims 140-141, Tendler discloses a mobile entertainment and communication device for communicating with remotely located telephones, comprising: a cell-phone in a portable housing of a size and weight for being handheld by a person for placing and receiving person-to-person telephone calls to and from remotely located telephones, the cell phone having a microphone and a speaker (see cellular phone 10, having microphone 14 and earpiece 16, see col. 5, lines 50-52), an audible alarm means including at least one of the speaker or a separate audible sound generator activation of module 20 causing message MAYDAY MAYDAY MAYDAY to be verbally broadcasted, see col. 6, lines 48-60), and an emergency button on the housing and operatively connected to the audible alarm means for selectively operating the audible alarm means (dialer and activation detector 24, coupled to the cellular telephone, see col. 5, lines 50-55, col. 6, lines 27-48), and means for causing operation of the microphone upon activation of the emergency call function for transmitting at least one of sounds or location information by telephone call (see col. 3, lines 60-65) . Tendler fails to teach a camera and causing the operation of the camera to transmit still images, combined sounds and moving images.

Oliver discloses a method for connecting a portable phone to an image capture device wherein images captured may be transmitted to another device (see col. 1, line 30 to col. 2, line 15).

It would therefore have been obvious to one ordinary skill in the art to incorporate the image capture device of Oliver into Tendler's emergency communication system in order to facilitate the capturing and transmission of sounds and images in emergency situations for enhanced assistance provision.

8. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shin (6,006,109) in view of Fujiwara (5,353,330).

Regarding claim 65, Shin discloses a mobile entertainment and communication device for communicating with remotely located telephones comprising: a housing of a palm-held size (cellular phone 500 housing), a cell phone provided in the housing and having means for selectively and wirelessly accessing the remotely located telephones (antenna 524 provides means for communicating with other telephones over the inherent cellular communication network), the cell phone inherently includes a microphone, a speaker, a memory and a microprocessor in the housing, a jack (510, 520), provided in the housing and operatively connected to the microprocessor for uploading data or downloading data between the cell phone and a computer or other devices (computer being able to transmit and receive data via portable telephone 500, see col. 3, lines 16-30, col. 4, line 63 to col. 5, line 38).

Shin fails to explicitly teach at least one of an earphone and microphone with a wire for connecting to a jack in the housing of the cell phone, a wireless earphone and

microphone separate from the housing for transmitting sounds to and from the cell phone, a speaker phone or a means for voice controlled dialing, each for hands-free cell phone operation.

In an analogous field of endeavor, Fujiwara discloses a portable telephone usable both as a portable and as an installed telephone (see abstract) and has means for voice-controlled dialing for hands-free cell phone operation (see Figs. 1-2, col. 1, lines 51-68, col. 2, lines 53-63).

It would therefore have been obvious to one of ordinary skill in the art to incorporate Fujiwara's voice dialing system having speech recognition into Shin's telephone device in order to provide a safe means for dialing especially when used while driving a vehicle as taught by Fujiwara.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Theimer (6,519,241) discloses a mobile telephone having Internet applications.

McNelley et al. (5,550,754) discloses a combination portable recording video camera and for recording and communicating over a telecommunication network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

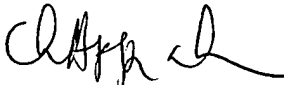
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA


CHARLES CORRIAH
PRIMARY EXAMINER